

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

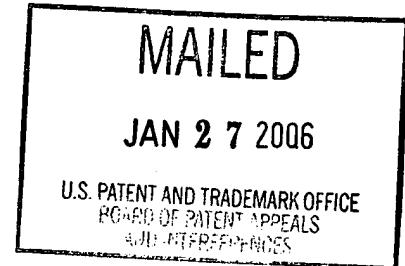
UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte PAUL L. HICKMAN AND JAMES J. GOUGH

Appeal No. 2005-2460
Application No. 09/648,715

ON BRIEF



Before RUGGIERO, BARRY, and NAPPI, Administrative Patent Judges.
RUGGIERO, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on the appeal from the final rejection of claims 1, 3-5, 7, 9, 11-14, and 16-18, which are all of the claims pending in the present application.

Appeal No. 2005-2460
Application No. 09/648,715

The claimed invention relates to a system and method for electronic mail notification in which a determination is made that it is time for at least one of a reminder notification action and a report notification action. For a reminder notification action, all action items which fall within a given range are obtained and processed into a reminder action item report and e-mailed to at least one designated recipient. For a report notification action, a list of completed action items in a given range is obtained and processed into a completed action report and e-mailed to at least one designated recipient.

Claim 1 is illustrative of the invention and reads as follows:

A method for electronic mail notification comprising:
determining that it is a time for at least one of a reminder notification action and a report notification action;
opening a docketing program;
running a report;
saving the report for further processing;
for a reminder notification action, obtaining all action items within a given range from said report and processing the action items into at least one action item report and e-mailing the at least one action item report to at least one designated recipient; and

Appeal No. 2005-2460
Application No. 09/648,715

for a report notification action, obtaining a list of completed action items in a given range from said report and processing the list of completed action items into at least one completed action report and e-mailing the at least one completed action report to at least one designated recipient.

The Examiner relies on the following prior art:

Milewski et al. (Milewski) 5,930,471 Jul. 27, 1999
(filed Dec. 26, 1996)

Ariyama et al. (Ariyama) 11-143936 May 28, 1999
(Published Japanese Patent Application)

Claims 1, 3-5, 7, 9, 11-14, and 16-18, all of the appealed claims, stand finally rejected under 35 U.S.C. § 103(a) as being unpatentable over Milewski in view of Ariyama.

Rather than reiterate the arguments of Appellants and the Examiner, reference is made to the Briefs¹ and Answer for the respective details.

OPINION

Initially, we note that Appellants have provided arguments as to the sufficiency of the drawings. However, the issue of the sufficiency of the drawings relates to a petitionable matter and not to an appealable matter. See Manual of Patent Examining

¹ The Appeal Brief (revised) was filed August 10, 2004. In response to the Examiner's Answer mailed October 19, 2004, a Reply Brief was filed December 23, 2004, which was acknowledged and entered by the Examiner as indicated in the communication mailed March 16, 2005.

Appeal No. 2005-2460
Application No. 09/648,715

Procedure (MPEP) §§ 1002 and 1201. Accordingly, we will not review the issue raised by Appellants on pages 5 and 6 of the Brief and pages 1-3 of the Reply Brief.

We have carefully considered the subject matter on appeal, the rejection advanced by the Examiner and the evidence of obviousness relied upon by the Examiner as support for the rejection. We have, likewise, reviewed and taken into consideration, in reaching our decision, Appellants' arguments set forth in the Briefs along with the Examiner's rationale in support of the rejection and arguments in rebuttal set forth in the Examiner's Answer.

It is our view, after consideration of the record before us, that the evidence relied upon and the level of skill in the particular art would not have suggested to one of ordinary skill in the art the obviousness of the invention as recited in claims 1, 3-5, 7, 9, 11-14, and 16-18. Accordingly, we reverse.

In rejecting claims under 35 U.S.C. § 103, it is incumbent upon the Examiner to establish a factual basis to support the legal conclusion of obviousness. See In re Fine, 837 F.2d 1071, 1073, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988). In so doing, the Examiner is expected to make the factual determinations set forth in Graham v. John Deere Co., 383 U.S. 1, 17, 148 USPQ 459, 467 (1966), and to provide a reason why one

Appeal No. 2005-2460
Application No. 09/648,715

having ordinary skill in the pertinent art would have been led to modify the prior art or to combine prior art references to arrive at the claimed invention. Such reason must stem from some teaching, suggestion or implication in the prior art as a whole or knowledge generally available to one having ordinary skill in the art. Uniroyal Inc. v. Rudkin-Wiley Corp., 837 F.2d 1044, 1051, 5 USPQ2d 1434, 1438 (Fed. Cir.), cert. denied, 488 U.S. 825 (1988); Ashland Oil, Inc. v. Delta Resins & Refractories, Inc., 776 F.2d 281, 293, 227 USPQ 657, 664 (Fed. Cir. 1985), cert. denied, 475 U.S. 1017 (1986); ACS Hosp. Sys., Inc. v. Montefiore Hosp., 732 F.2d 1572, 1577, 221 USPQ 929, 933 (Fed. Cir. 1984). These showings by the Examiner are an essential part of complying with the burden of presenting a prima facie case of obviousness. Note In re Oetiker, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992).

With respect to the Examiner's 35 U.S.C. § 103(a) rejection of appealed independent claims 1, 5, 7, 9, 12-14, 17, and 18 based on the combination of Milewski and Ariyama, Appellants assert that the Examiner has failed to establish a prima facie case of obviousness since proper motivation for the Examiner's proposed combination has not been set forth. In addition, Appellants assert that, even if combined, all of the claimed limitations would not be taught or suggested by the applied

Appeal No. 2005-2460
Application No. 09/648,715

Milewski and Ariyama references. After reviewing the arguments of record from Appellants and the Examiner, we are in general agreement with Appellants' position as stated in the Briefs.

In our view, to whatever extent the missing reminder time determination feature of Milewski may be present in Ariyama, we find no indication from the Examiner as to how and in what manner the Milewski reference would be combined with Ariyama to arrive at the claimed invention. The mere fact that the prior art may be modified in the manner suggested by the Examiner does not make the modification obvious unless the prior art suggested the desirability of the modification. In re Fritch, 972 F. 2d 1260, 1266, 23 USPQ2d 1780, 1783-84 (Fed. Cir. 1992). In our view, given the disparity of problems addressed by the applied prior art references, and the differing solutions proposed by them, any attempt to combine them in the manner proposed by the Examiner could only come from Appellants' own disclosure and not from any teaching or suggestion in the references themselves.

We are further of the view that, even assuming arguendo that proper motivation were established for the combination of Milewski and Ariyama, the resultant combination would not satisfy the particular limitations of the appealed claims. As asserted by Appellants (Brief, page 7; Reply Brief, page 3), we find no disclosure in Milewski, or in Ariyama, which would satisfy the

Appeal No. 2005-2460
Application No. 09/648,715

"opening a docketing program" feature which appears in each of the appealed independent claims. We agree with Appellants that the portion of Milewski relied upon by the Examiner, i.e., column 8, lines 30-37 which is directed to the accessing of a structured response template by a sender, has no relationship to a "docketing program" as claimed.

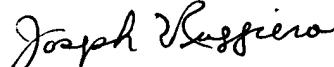
We recognize that the Examiner, at page 8 of the Answer, has expanded the line of reasoning which asserts that Milewski provides a disclosure of the claimed "docketing program." According to the Examiner, the accessing of controller 12 by sender station 14 in Milewski using conventional stored program instructions would satisfy the claimed "opening a docketing program" limitation. We can find no basis on the record before us for the Examiner interpreting the claim language in this manner. In our view, the Examiner's interpretation could only be reached by pointedly ignoring the precise language of the claims on appeal, i.e., effectively and improperly reading out the language "docketing program" from the claims. Our reviewing courts have held that, in assessing patentability of a claimed invention, all the claim limitations must be suggested or taught by the prior art. In re Royka, 490 F.2d 981, 180 USPQ 580 (CCPA 1974). All words in a claim must be considered in judging the

Appeal No. 2005-2460
Application No. 09/648,715

patentability of that claim against the prior art. In re Wilson, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970).

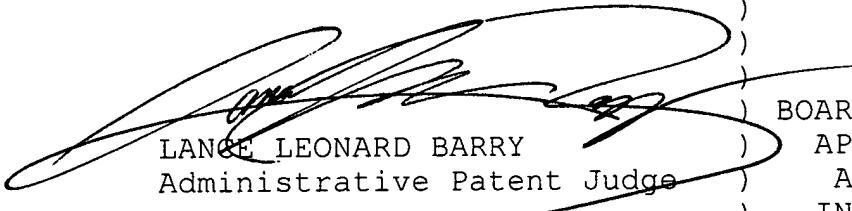
In conclusion, since we are of the opinion that the prior art applied by the Examiner does not support the obviousness rejection, we do not sustain the rejection of independent claims 1, 5, 7, 9, 12-14, 17, and 18, nor of claims 3, 4, 11, and 16 dependent thereon. Therefore, the decision of the Examiner rejecting claims 1, 3-5, 7, 9, 11-14, and 16-18 under 35 U.S.C. § 103(a) is reversed.

REVERSED



JOSEPH F. RUGGIERO
Administrative Patent Judge

)
BOARD OF PATENT
APPEALS
AND
INTERFERENCES


LANCE LEONARD BARRY
Administrative Patent Judge
ROBERT NAPPI
Administrative Patent Judge

JFR/CE

Appeal No. 2005-2460
Application No. 09/648,715

PERKINS COIE LLP
101 JEFFERSON DRIVE
MENLO PARK, CA 94025-1114